

### **REMARKS**

Claims 1-11, 13-17, and 19-23 are pending in the application. Claims 1-11, 13-17, and 19-23 have been rejected. Claims 1, 3, 6, 8, 11 and 17 are being amended. Claims 2 and 7 are being cancelled in favor of respective base Claims 1 and 6. No new matter is being introduced by way of these amendments.

The Specification as originally filed has been amended at page 24 to correct a misspelling of the term “statistical”. No new matter is being introduced by way of this amendment.

#### **35 U.S.C. §101 Rejections**

Claims 1-11, 13-17, and 19-23 have been rejected under 35 U.S.C. 101 because the claimed invention is purportedly in violation of the CAN-SPAM Act of 2003. The Office Action at Page 2, Part 3 states: “A ‘test email message’ that is used to ‘verify’ a ‘potential email address’, regardless of whether it is a ‘business email address’, is spam.” Applicants understand that a “test email message” may constitute “spam” under a broad definition of the term “spam”. However, the claimed “test email message” does not fall within the definition of “spam” as it is defined by the CAN-SPAM Act of 2003. In fact, the CAN-SPAM Act of 2003 does not even use the term “spam”. Instead it uses the phrase “commercial electronic email messages.” The CAN-SPAM Act of 2003 defines “commercial electronic email messages” as “any electronic mail message the primary purpose of which is the commercial advertisement or promotion of a commercial product or service.” Section 3(2)(A).

MPEP 2107.02 specifies that “[t]he claimed invention is the focus of the assessment of whether an applicant has satisfied the utility requirement” under 35 U.S.C. 101. The primary purpose of the “test e-mail messages” of Claim 1 is to verify “potential e-mail addresses.” No other purpose is stated in the claim. Indeed, the preamble of Claim 1 makes clear that the primary purpose of the claimed invention is to generate an e-mail address, not to send unsolicited e-mail messages to advertise or promote a commercial product or service: “A method for generating an e-mail address of a person for whom e-mail address information is missing.” Moreover, as stated in Claim 1, the primary purpose of the “test e-mail messages” is “to determine a response of the e-mail server to the test email messages.” The test e-mail message can be a message with empty or blank subject and body fields. Nothing in Claim 1 indicates a primary purpose or even a purpose of advertising or promoting a commercial product or service.

MPEP 2107.02 further specifies that “regardless of the category of invention that is claimed (e.g., product or process), an applicant need only make one credible assertion of specific utility for the claimed invention to satisfy 35 U.S.C. 101.” On page 6 of the specification as originally filed, Applicants suggest that the claimed invention may be useful to “individuals who want to search for or reestablish contact with old friends, acquaintances or colleagues.” (Page 6, lines 14-15.) This particular use of the invention of Claim 1 does not violate the CAN-SPAM Act of 2003 because its primary purpose is hardly the commercial advertisement or promotion of a commercial product or service. The Office Action at Page 2, Part 3 states that Applicants have “admitted the useful nature of the invention in targeted advertising campaigns toward individuals on page 6 of the specification, lines 11-12.” According to MPEP 2107.02, however, “[s]tatements made by the applicant in the specification or incident to prosecution of the application before the Office cannot, standing alone, be the basis for a lack of utility rejection under 35 U.S.C. 101.”

Sec. 5(b)(1) of the CAN-SPAM Act of 2003 covers address harvesting and dictionary attacks. However, this section does not apply unless the e-mail message is a “commercial electronic mail message.” As described above, several uses for the “test email message” of Claim 1 do not have the primary purpose of commercial advertisement or promotion of a commercial product or service. The same can be said for base Claims 6, 11 and 17. For the foregoing reasons, base Claims 1, 6, 11 and 17 as now amended comply with the requirements (i.e., are not literally or necessarily in violation) of the CAN-SPAM Act of 2003. Thus, the requirements of 35 U.S.C. 101 are met and this rejection of Claims 1, 3-6, 8-11, 13-17 and 19-23 should be withdrawn. Claims 2 and 7 are now cancelled.

#### 35 U.S.C. §103 Rejections

Claims 1-11, 13-17, and 19-23 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Cranor et al. (“Spam!”, Communications of the ACM, August 1998, Vol. 41, No. 8, pp. 74-83) (“Cranor”). As stated in the Office Action at Page 4, Part 10, Cranor “disclosed that spamming was performed by harvesting information such as email addresses from the World Wide Web.” However, Cranor fails to teach or suggest all the claim limitations of Claim 1 as now amended including “deducing from the working e-mail address, format of e-mail addresses to the respective organization” and “verifying each potential e-mail address by sending test e-mail messages using the potential e-mail addresses to an e-mail server.” In fact, even

assuming that the “test e-mail messages” of Claim 1 constitute “spam”, the Office Action at Page 4, Part 10 states that “Cranor failed to disclose a method of . . . creating spam by harvesting information from the World Wide Web.” Because Cranor fails to establish a prima facie case of obviousness, Applicants respectfully request that the rejection of Claim 1 under 35 U.S.C. 103(a) be withdrawn.

Base Claim 6 includes similar limitations as base Claim 1, therefore Applicants respectfully request that the rejection of Claim 6 under 35 U.S.C. 103(a) be withdrawn for at least the same reasons.

Because claims 3-5 and 8-10 depend from base claims 1 and 6, respectively, Applicants respectfully request that the rejection of these claims under 35 U.S.C. 103(a) be withdrawn for at least the same reasons.

As with base Claims 1 and 6, Cranor fails to teach or suggest all the claim limitations of base Claims 11 and 17. Because Cranor fails to establish a prima facie case of obviousness, Applicants respectfully request that the rejection of base Claims 11 and 17 under 35 U.S.C. 103(a) be withdrawn.

Because claims 12-16 and 18-23 depend from base claims 11 and 17, respectively, Applicants respectfully request that the rejection of these claims under 35 U.S.C. 103(a) be withdrawn for at least the same reasons.

Claims 1 and 6 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick et al. (U.S. Pat. No. 6, 377,936) (“Henrick”) in view of Miller (Online Search Secrets, 173-179).

Claims 1 and 6 have been amended to include all the limitations of respective dependent claims 2 and 7. As stated in the Office Action at Page 6, Part 25, “Henrick in view of Miller fails to disclose” the elements of dependent Claims 2 and 7. The Office Action at Pages 6 and 7 indicates that Biliris discloses the limitations of dependent Claims 2 and 7 and that it would have been obvious to combine Biliris with Henrick and Mills to produce the invention claimed in Claims 1-2 or Claims 6-7.

Biliris discloses a messaging system which does not require the explicit enumeration of mailing lists. Intended message recipients may be specified in a declarative address. A messaging server is coupled to an address resolution module which: (i) receives a declarative address associated with a message, (ii) resolves (i.e., translates) the declarative address into at least one messaging address, and (iii) transmits the at least one messaging address to the

messaging server. The address resolution module resolves a declarative address by querying a database system containing a directory or mailing list of messaging addresses.

The Office Action at Page 7, Part 26 correctly states that “Biliris discloses receiving a message from a sender system with a declarative address.” In contrast, the invention as claimed in now amended base Claims 1 and 6 obtains a working e-mail address. The declarative address is not a functioning e-mail address. The messaging server disclosed in Biliris cannot transmit a message to a recipient system using the declarative address. The messaging server can only transmit a message to a recipient system using a messaging address, such as an e-mail address, derived from the declarative address.

In further contrast to Biliris, the invention as claimed in now amended base Claims 1 and 6 obtains a working e-mail address that is not the e-mail address of a subject person. The declarative address disclosed in Biliris represents the e-mail address of the subject person or at least one subject person. Therefore, Biliris does not teach, suggest, or otherwise make obvious the limitations presented in dependent Claims 2 and 7, which have been included in now amended base Claims 1 and 6, respectively.

Because Henrick, Miller, and Biliris, alone or in any combination, do not teach, suggest or otherwise make obvious the limitations of now amended base claims 1 and 6 (“obtaining a working e-mail address . . . not being the e-mail address of a subject person” and “verifying each potential e-mail address by sending test e-mail messages using the potential e-mail addresses to an e-mail server”), Applicants respectfully request that the rejection of base Claims 1 and 6 under 35 U.S.C. 103(a) be withdrawn.

Claims 4 and 9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick in view of Miller in further view of Mills (Australian Patent Abstract No. AU-A-53031/98).

Mills does not add to Henrick and Miller “deducing from the working e-mail address, format of e-mail addresses” and “verifying each potential e-mail address by sending test e-mail messages . . . to an e-mail server” as claimed in now amended base Claims 1 and 6. Because claims 4 and 9 depend from base Claims 1 and 6, respectively, Applicants respectfully request that the rejection under 35 U.S.C. 103(a) be withdrawn for at least the same reasons.

Claims 5 and 10 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick in view of Miller in view of Mills as applied to claim 4 and in view of Barroux (U.S. Patent No. 5,923,850).

Barroux does not add to Henrick, Miller, and Mills “obtaining a working e-mail address . . . not being the e-mail address of a subject person” and “verifying each potential e-mail address by sending test e-mail messages . . . to an e-mail server” as claimed in now amended base Claims 1 and 6. Because claims 5 and 10 depend from base Claims 1 and 6, respectively, Applicants respectfully request that the rejection under 35 U.S.C. 103(a) be withdrawn for at least the same reasons.

Claims 2-3 and 7-8 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick in view of Miller in view of Biliris et al. (U.S. Publication No. 2001/0009017) (“Biliris”).

Claims 2 and 7 have been cancelled. Claims 3 and 8 have been amended to depend from base Claims 1 and 6 instead of dependent Claims 2 and 7.

Because claims 3 and 8 depend from now amended base claims 1 and 6, respectively, Applicants respectfully request that the rejection under 35 U.S.C. 103(a) be withdrawn for at least the same reasons given for base Claims 1 and 6 above.

Claims 11, 13, 17, 19, and 20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Knight et al. (U.S. Patent No. 6, 493,703) (“Knight”) in view of Feridun et al. (U.S. Patent No. 6,336,139) (“Feridun”).

As stated in MPEP 2143, “[t]o establish a prima facie case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, . . . to combine reference teachings.” The Office Action at Page 8, Part 34 states that “Knight gives motivation for the combination by stating that not distinguishing between subject areas (changes in a person) results in frustration to the user. [See Knight, column 9, lines 45-54.]” This statement is correct insofar as it presents a problem solved by the invention disclosed in Knight. Applicants, however, do not see how this statement provides a suggestion or motivation to combine Knight with Feridun. Knight and Feridun disclose different inventions to solve different problems. Knight discloses an electronic message board system that classifies content from discussion boards or newsgroups to substantially eliminate “the need for manual, cumbersome review of individual messages throughout dozens of newgroups [sic] with non-illuminating identifiers.” (Knight, col. 9, lines 48-50.) Feridun, on the other hand, discloses a method of event correlation to manage events generated by managed computers in a large and complex distributed computer network. One of

ordinary skill in the art faced with the problem of resolving two database records of potentially a same person would not look to event correlation as is disclosed in Feridun.

In addition, neither Knight nor Feridun disclose all the elements of now amended base Claims 11 and 17. First, neither Knight nor Feridun disclose comparing the name of a person and another separate piece of information indicated in a first record with the name of a person and another separate piece of information indicated in a second record as claimed in now amended base Claim 17. Instead, Knight classifies or sorts content from discussion boards or newsgroups and Feridun correlates events generated by distributed computers. Second, neither Knight nor Feridun disclose the further step of merging the first and second records into one record if the name of the person is the same in the two records and the other two separate pieces of information between the two records are reasonably the same as claimed in base Claim 17. Instead, Knight classifies or sorts content from discussion boards or newsgroups and Feridun aggregates correlated events.

Since neither Knight, Feridun, nor the knowledge generally available to one of ordinary skill in the art provide any suggestion or motivation to combine the teachings of Knight and Feridun, Applicants respectfully request that the rejection under 35 U.S.C. 103(a) be withdrawn. Furthermore, because Knight and Feridun, alone or in combination, do not teach, suggest, or otherwise make obvious the limitations of now amended claim 17 (“comparing the name of a person indicated in a first record with the name of a person indicated in a second record; determining whether another two separate pieces of information between the first and second records are reasonably the same if the name comparing results in a match; merging the first and second records into one record when . . . the other two separate pieces of information . . . [are] reasonably the same.”), Applicants respectfully request that the rejection of Claim 17 under 35 U.S.C. 103(a) be withdrawn. Base claim 11 includes similar limitations as claim 17; therefore, Applicants respectfully request that the rejection of claim 11 under 35 U.S.C. 103(a) be withdrawn for at least the same reasons.

Dependent claim 13 depends from now amended base claim 11 and dependent claims 19-20 depend from now amended base claim 17. As explained above, there is no suggestion or motivation to combine Knight and Feridun and the same references, alone or in combination, do not teach, suggest, or otherwise make obvious the limitations of base claims 11 and 17. Since claims 13 and 19-20 depend from now amended base claims 11 and 17, respectively, Applicants

respectfully request that the rejection of Claims 11, 13, 17, 19 and 20 under 35 U.S.C. 103(a) be withdrawn for at least the same reasons.

Claims 14 and 21 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Knight and Henrick. Henrick does not add to Knight merging the first and second records into one record if the name of the person is the same in the two records and the other two separate pieces of information between the two records are reasonably the same as claimed in base Claims 11 and 17. Because claims 14 and 21 depend from now amended base claims 11 and 17, respectively, Applicants respectfully request that the rejection of Claims 14 and 21 under 35 U.S.C. 103(a) be withdrawn for at least the same reasons.

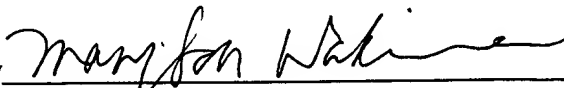
Claims 15-16 and 22-23 have been rejected under 35 U.S.C. 103(a) being unpatentable over Knight, Henrick, in view of Biliris. Henrick and Biliris do not add to Knight merging the first and second records into one record if the name of the person is the same in the two records and the other two separate pieces of information between the two records are reasonably the same as claimed in now amended base Claims 11 and 17. Because claims 15-16 and 22-23 depend from now amended base claims 11 and 17, respectively, Applicants respectfully request that the rejection of Claims 15-16 and 22-23 under 35 U.S.C. 103(a) be withdrawn for at least the same reasons.

### CONCLUSION

In view of the above amendments and remarks, it is believed that all claims (Claims 1, 3-6, 8-11, 13-17, and 19-23) are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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